

ARCELORMITTAL FRANCE v. AK STEEL CORP., Appeal No. 2014-1189 (Fed. Cir. May 12, 2015). Before Dyk, Wallach, and Hughes. Appealed from D. Del. (Judge Robinson).

### Background:

ArcelorMittal sued AK Steel for infringement of its patent. At issue was the construction of the claimed phrase "a very high mechanical resistance" recited in claim 1. The district court construed this phrase to mean a tensile strength greater than 1500 MPa. Based on this construction, a jury found that AK Steel did not infringe ArcelorMittal's patent, and that it was invalid for anticipation and obviousness. On appeal, the Federal Circuit agreed with the district court's claim construction, but reversed and remanded the case on other grounds.

While awaiting remand, ArcelorMittal sought reissue to correct the claim construction. During the reissue proceedings, two dependent claims were added: claim 23, reciting that the mechanical resistance is in excess of 1000 MPa, and claim 24, reciting that the mechanical resistance is in excess of 1500 MPa. The Patent Office granted the reissue application. ArcelorMittal then amended its complaint to allege infringement of the reissued patent.

At trial, on summary judgment, the district court invalidated all of the claims, concluding that the claims had been impermissibly broadened in the reissued patent.

### Issue/Holding:

Were the claims of the reissued patent impermissibly broadened? Yes (claim 1 and dependent claim 23), and No (dependent claim 24). Affirmed-in-part, reversed-in-part, and remanded.

### Discussion:

On appeal, ArcelorMittal argued that the reissued claims were no broader than the original claims, as evidenced by the successful prosecution of the reissue application, and that the district court erred in invalidating all of the claims.

The Federal Circuit relied on the "law-of-the-case" doctrine, which suggests that when a court decides upon a rule of law, that decision should govern the same issues in subsequent stages in the same case. The Federal Circuit concluded that the successful prosecution of the reissued patent is not "new evidence" that is sufficient to constitute an "extraordinary circumstance" to deviate from this doctrine because this conflicts with the validity analysis under §251, which requires comparing the scope of the original claims to the reissued claims. The Federal Circuit reasoned that allowing a reissued claim to define the scope of the original claim would make this comparison meaningless. The court determined that the dispositive question to ask is whether the original claim has the meaning sought by ArcelorMittal for the reissue claim, not what the original claim means in view of the reissued claim.

Having found that the "law-of-the-case" doctrine applies, the Federal Circuit concluded that the district court was bound by the original construction of the claimed term "a very high mechanical resistance," and correctly concluded that claim 1 and dependent claim 23 were impermissibly broadened. However, because dependent claim 24 had the same scope as the original claim construction, the district court erred in finding that dependent claim 24 was invalid for impermissible broadening.